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REMARKS

Applicants have amended the specification and claim 21 as suggested by the Examiner to correct typographical errors. Claim 21 was not amended to avoid any reference. Withdrawal of the objection to claim 21 is requested. Claims 22-26 have been added without adding any new matter.

Applicants thank the Examiner and his supervisor for the many courtesies extended in the interview of November 23, 2004. Applicants thank the Examiner for indicating that the §112 rejections to claims 5, 9, 10, 19 and 20 would be withdrawn upon submission of this written response. The Examiner's Interview Summary does not accurately reflect Applicants' counsel's statements during the interview.

A. Claims 9, 10, 19, and 20 were rejected under 35 U.S.C. §112

The §112 rejection of claims 9, 10, 19 and 20 is traversed. One of ordinary skill in the art would be able to practice the claimed invention without undue experimentation. Indeed, the Examiner fails to even allege that undue experimentation would be necessary, and therefore cannot have met even a *prima facie* case of non-enablement. See, MPEP §§2106, 2106.01.

Furthermore, the MPEP specifically requires the Examiner to establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. See, e.g. MPEP §2106.01. Those of ordinary skill in the art are aware of condition limits and criteria to meet or exceed condition limit, as claimed in claims 9 and 19.

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Additionally, claims 10 and 20 provide that the claimed condition limits are determined based on usage factors. Those of ordinary skill in the art are aware of usage factors and how to use usage factors.

Applicants request the Examiner make a showing that undue experimentation would be necessary to make or practice the claimed invention. Lacking such a showing, Applicants request withdrawal of the rejections to claims 9, 10, 19 and 20.

B. Claims 2, 5, and 12 were rejected under 35 U.S.C. §112 as indefinite

The §112 rejections of claims 2, 5, and 12 is traversed.

With respect to claims 2 and 12, the Examiner's rejections are not founded in law and have no reasonable basis. In order to comply with the second paragraph of §112, a claim need only set out and circumscribe the invention with a reasonable degree of precision and particularity. The definiteness of the language must be analyzed, not in a vacuum, but always in light of the teachings of the disclosure, as it would be interpreted by one of ordinary skill in the art. See, MPEP §2106.

Thus, Applicants need not disclose "why" claimed elements are claimed. One of ordinary skill in the art would find the claimed elements set forth with a reasonable degree of precision, and would find the claimed elements definite.

As to claims 5 and 15, the rejections are traversed. Claims 1 and 11 recite "a method of operating a plurality of disks" and "a program for operating a plurality of disks". Claim 5 depends from claim 1 and requires "assigning a portion of the disks to the first tier." Claim 5 is definite. Claim 15 depends from claim 11 and requires "assigning a portion of the disks to the first tier." Claim 15 is definite.

However, in an effort to expedite prosecution, Applicants have amended claims 2 and 5. Applicants maintain their claims to any and all equivalents of the unamended claims.

Claims 3, 4, 13 and 14 do not depend from indefinite claims and therefore claims 3, 4, 13 and 14 do not inherit any indefiniteness.

Withdrawal of the rejections to claims 2, 3, 4, 5, 12, 13, 14 and 15 is requested.

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C. Claims 1, 3, 6, 7, 9-12, 13, 16, 17 and 19-21 were rejected under 35 U.S.C. §103(a) as unpatentable over Nunnely in view of Craig

The §103(a) rejection of claims 1, 3, 6, 7, 9-12, 13, 16, 17 and 19-21 is traversed.

In order to maintain this §103(a) rejection, each and every claimed element must be taught or suggested by the references, alone or in combination, in at least as great detail as claimed. Furthermore, the references must be analogous art. Independent claims 1, 11 and 21 each require providing a first tier of at least one disk, the first tier storing at least one popular unit and providing a second tier of at least one disk, the second tier storing at least one unpopular unit.

The Examiner correctly recognizes the failure of Nunnely to teach providing a first tier of at least one disk, the first tier storing at least one popular unit and providing a *second tier of at least one disk*, the second tier storing at least one unpopular unit.

However, Craig does not teach the claimed elements, and is nonanalogous art.

Craig teaches a media server for supplying video and multi-media data over the public switched telephone network. The Craig system is online storage units 278, 282, and 286. Further included is Archival Magnetic Tape 290. Craig also refers to identification 290 as "archival storage 290". See, e.g. column 9, lines 30-41 and column 10, lines 31-34. Since Craig teaches use of *archival magnetic tape*, Craig does not teach providing a second tier of at least one *disk*. Those of ordinary skill in the art readily recognize the differences between tape and disk memory.

In order to rely on a reference under 35 U.S.C. §103, the reference must be analogous art. The reference must either be in the field of applicants' endeavor or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See, MPEP §2141.01(a), *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

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Craig is not concerned with the field of Applicants' endeavor, and it is therefore not analogous art and cannot support the §103(a) rejections. Applicants' endeavor is directed at RAID (Redundant Arrays of Inexpensive Disks) systems, and not to media servers for supplying data over the public switched telephone network. There is no grounds to suggest that one concerned with RAID systems would consult literature relating to media servers for supplying data over the public switched telephone network. First, use of a RAID system is generally unrelated to use of the public switched telephone network. Those of ordinary skill in the art readily recognize that RAID (Redundant Arrays of Inexpensive Disks) do not pass information using phone lines. Second, RAID systems generally are able to access disks simultaneously (see page 1, lines 22-24), which is a feature not available in tape systems such as the system taught in Craig.

In *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992), the court found that the reference and invention were not part of the same endeavor where the reference taught a different structure for a different purpose under different conditions. In this case, the structure is different, the purpose is different and there are different conditions. First, the claim requires a second tier of at least one *disk* rather than a tape, so the structure is different. Second, the purpose of providing a second tier of at least one *disk* is different than archiving to tape for media servers for supplying data over the public switched telephone network. Third, different conditions exist, as Applicants field of endeavor is related to RAID systems rather than media servers for supplying data over the public switched telephone network.

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In *Wang Laboratories, Inc. v Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993), the court found that a SIMM case was not related to compact modular memories, even though both SIMMS and compact modular memories relate to "memory." In this matter, as in Wang, the claims are intended for RAID systems, whereas the reference system was developed for use in unrelated systems, and only teaches use of tape drives.

Furthermore, the Examiner provides no evidence of the level of skill of one of ordinary skill in the art to support a finding of obviousness or that one of such skill would consult these references. Without establishing the level of skill, there can be no objectivity in the determination of obviousness. See, e.g., MPEP §2141.03. "The importance of resolving the level of skill of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991). Furthermore, there is no indication reflected in the prior art itself of the level of ordinary skill in the art.

Therefore, Craig cannot be considered analogous art, and the §103(a) rejection premised in part on Craig is flawed.

Claims 2-10 and 12-20 each depend directly or indirectly from claims 1 or 11 respectively. Therefore, claims 2, 3, 6, 7, 9, 10, 12, 13, 16, 17 and 19-21 are patentable over the references for at least the same reasons.

Withdrawal of the rejections to claims 1, 3, 6, 7, 9-12, 13, 16, 17 and 19-21 is requested.

D. New claims 22-25

Each and every element of new claims 22-25 is not disclosed, taught or suggested by the references, and therefore claims 22-25 are patentable over the prior art.

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CONCLUSION

The Applicant respectfully submits that claims 1-25 as listed herein fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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